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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,132	12/20/2001	Stuart T. Gordon	82142SMR	2406

7590 06/25/2003
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EXAMINER

LE, HOA VAN

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	10/028,132	GORDON ET AL.	
	Examiner	Art Unit	
	Hoa V. Le	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-10 and 12-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>07</u> . | 6) <input type="checkbox"/> Other: |

This is in response to Papers filed on 05 June 2003.

I. Applicants elect E-2 species on 27 January 2003 being acknowledged. The E-2 species has been considered and searched. The consideration and search are extended to the applied species. Other non-elected species have not been considered, searched or examined until all of the applied species are overcome.

II. The first independent claim 1 is considered as the main invention. Claims 2-10 and 12-23 are considered as the secondary embodiments and permitted to be rejoined with the main invention of the independent claim 1 when it found to be allowable.

III. A. (1) It is allowed to claim by a functional, characteristic or chemical property of a material (In re Swinehart, 169 USPQ 226). (2) However, a claimed functional, characteristic or chemical property of a material carries with a risk (In re Swinehart, 169 USPQ 228). Therefore, one should be carefully looked into it for his own benefit. Please also see In re Schreiber, 44 USPQ2d 1432 since it is reasonable that the Office is not supplied, provided or equipped with a sufficient facility to carry out a test for the functional or characteristic properties as claimed in accordance with the authority stated in In re Best, 195 USPQ 430; Ex parte Maizel, 27 USPQ2d 1662 or Ex parte Phillip, 28 USPQ2d 1302. For example, the language "CAR is a carrier moiety...with oxidized developing agent", "ETA is a releasable...the pyrazolidinone ring" or the like has been considered as a functional, characteristic and chemical properties of a material.

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B. (2) Within the authority of the Office being granted by the authority in the court of law, applicant is required to show or provide an evidence to the contrary to the applied material and process from the applied reference for the claimed property of the material and process as claimed for its patentability in accordance with the authority stated in *In re Swinehart*, 169 USPQ 228. It is should be noted that an argument alone (1) would be taken a place of an objective evidence as a matter of law (2) has and (3) is given a little to no value.

VI. Claims 1-10 and 12-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language "contrast enhancing amount" is understandable only as such as those uses in the Examples. What is an amount in mol/m^2 or g/m^2 that is not able to provide a contrast enhancement? Until applicants convincingly provide such evidence. The claimed language is reasonably considered and examined to about the amount as tested in the Examples only.

A claim may be allowed for a reason other than the claimed contrast-enhancing amount. In such event, any amount that is reasonable different from those tested in the Examples must be firstly produced by a convincing evidence with all possible broadly claimed embodiments in the claims being included by applicants in a contest. Therefore, applicants are urged to do so for a timely and properly examined process while the instant application is in the Office for an examination. It would like to see a test being done to this issue for the record and examination.

V. Applicants' prior art submission filed on 28 April 2003 has been considered.

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VI. In view of the Amendment filed on 05 June 2003 Saito et al (5,605,786 as submitted) alone or with Lunt et al (6,110,657 as submitted) rejection is withdrawn.

VII. Claims 1-10 and 12-23 with respect to the applied and elected E-2 species are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakai et al (5,830,627 as submitted) alone or with Lunt et al (6,110,657 as submitted).

Nakai et al disclose, teach, suggest, demonstrate and reduce to practice with a method for a color development of a photosensitive silver bromiodide photographic material in less than 200 seconds; wherein a dye-forming unit containing a compound being read on the general formula as claimed being close to a support of the photographic material. Please see the whole disclosure of each of the applied references, especially in Nakai et al at compounds 29-30, 34-35, 38, 42, 45-48, 53-54, 57 and 86-94, col.79:23 to 81:14 and Examples. Since Nakai et al disclose, teach, suggest, demonstrate and reduce to practice the essential and main embodiments of the claimed invention, claims 1-23 are found to be rendered prima facie obvious by Nakai et al alone. Lunt et al compound E-2, which is the same as that elected species of the record, and its equivalent compounds E(1 and 3-17) and C(1-3) are applied in a dye-forming unit being close to a support of a photosensitive silver bromiodide photographic material. Please also especially in Lunt et al at Examples. Since the above references are related to the related compounds being applied in a dye-forming unit which is close to the support of a photosensitive silver bromiodide photographic material and a color developing process in less than 200 seconds as claimed, it would have being obvious to one having ordinary skill in the art at the time the invention was made to apply or use the related compound from Lunt et al as those disclosed,

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taught, suggested, demonstrated and reduced to practiced to obtained the same or substantially the same result as disclosed, taught, suggested, demonstrated, reduced to practices and obtained in Nakai et al. The showings in the Examples of the instant application have been considered but are insufficient and much more broader than those being drawn in the claims. For the newly added language "least light sensitive layer", please especially see Nakai et al at col.132:54 and "contrast enhancing amount", please especially see Nakai et al at col.132:55. Applicants are urged, requested and required to show by a convincing evidence that (1)none of the applied compounds would be able to provide a contrast enhancement and (2) the applied amount about 0.35 mmol/m² is not a contrast-enhancing amount as a matter of law. An argument alone is given a little value since it is insufficient to take a place of a convincing evidence as required by law.

VIII. Applicant's arguments filed 05 June 2003 have been fully considered but they are not persuasive.

Applicants urge that some of the applied compounds in Nakai et al in the Office action mailed on 19 February 2003 in the contain (1) a bonding group -O-CO- or -Zn-. The above applied compound containing none of the above groups.

To overcome the above applied references applicants are urged, requested and required to provide a convincing evidence to the contrary with respect to the properties of the material and amount as claimed to the applied compounds and amount as a matter of law. . An argument alone is given a little value since it is insufficient to take a place of a convincing evidence as required by law.

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IX. Applicant's amendment necessitated the rejection on the record to be modified.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

X. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 703-308-2295. The examiner can normally be reached on 6:30AM-5:00PM, M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone number of the examiner is (703)746-7172.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
24 June 2003

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le